

REMARKS

In this response, Applicant has amended claim 1 for the purpose of placing the claims in condition for Appeal. The amendments are typographical or stylistic in nature. In the Office Action, the Examiner provides new grounds for rejection based on US Patent Application Publication No. 2003/0019216 to Ikatura et al. ("Ikatura").

***Improper Final Rejection***

The Office Action should not have been made final. "[S]econd or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)..." MPEP 706.07(a). The Examiner has introduced a new ground of rejection not necessitated by Applicant's amendment. The Examiner acknowledges that grounds for rejection are new. Final Office Action at page 11. The new grounds for rejection are based on Ikatura. The Ikatura reference is newly cited in the Application, appearing first in the Image File Wrapper in a list of references cited by the Examiner dated June 23, 2006.

The Examiner acknowledges in the Final Office Action that Applicant's arguments with respect to claim 1 had been fully considered and found to be persuasive. *See* Final Office Action, Page 11. The Examiner withdrew the rejections of claims 1-5 and 7-10. *Id.* In the previous Office Action allowable subject matter was identified in claim 6. September 15, 2005 Office Action, page 4. Therefore, the Examiner could have allowed claims 1-10, but instead presented new grounds for rejection based on Ikatura.

The Examiner alleges that the new grounds for rejection are necessitated by Applicant's amendment. Applicant respectfully disagrees. Applicant amended the claims to advance prosecution and more clearly distinguish the claimed subject matter from art that had been newly cited in the Office Action of April 22, 2005. The limitations to the claims added by the amendment necessarily are the sole basis for the Examiner's allegation. However, these limitations had been previously considered in the Application. More specifically, Applicant added a limitation to the claims requiring that the recited thermal barrier define a cavity thermally isolated from the recited transfer plate where the cavity was adapted to house a recited charge-coupled device. These aspects were fully disclosed in the Specification and raised by Applicant in a response filed June 21, 2005 to an April 22, 2005 Office Action. For example, in the June 21, 2005 response, Applicant noted that:

One aspect of the present invention includes "mounting said transfer plate to a thermal barrier" (claim 1) or "said transfer plate mounted to a thermal barrier operative to prevent heat transfer between said thermoelectric cooling device and said housing" (claim 11). This feature, taught on page 7, lines 22-26 of the specification, recites "Additionally, spacer 117 may be dimensioned to facilitate or to allow positioning of hot side 131 of TEC 130 in a suitable location for mounting (through transfer plate 180) onto a thermally insulated structure, or "thermal barrier," such that heat generated by operation of TEC 130 is not re-circulated back to cavity 11, in general, nor to CCD 199, in particular. In contrast, none of the cited references have a thermal barrier that operates in such a manner. Kiga teaches pulling heat away from thermoelectric semiconductor elements, but no thermal barriers in a sealed cavity as described by the specification, and claimed by the Applicant."

Thus, Applicant highlighted certain differences between the claimed invention and the cited prior art. Examiner Filip Zec fully considered the Applicant's argument, acknowledged Applicant's position to be persuasive and withdrew rejections based on, *inter alia*, the above cited description. September 15, 2005 Office Action, page 2. Thus, the Examiner was aware of the intended scope of the claims.

Assuming *arguendo* that Ikatura is relevant to the examination of the presently claimed invention, it follows that Ikatura should have been cited in the September 15, 2005 Office Action. Therefore, Applicant's subsequent amendment did not necessitate new grounds for rejection because the amendment raised no new issues in the prosecution of the present Application.

For at least these reasons, Applicant respectfully submits that the rejections of the claims have been prematurely made final and the Final Office Action should be withdrawn.

**CONCLUSION**

In view of the foregoing, Applicant requests withdrawal of the Final Office Action and either a notice of allowance or issuance of a new Non-Final Office Action on the merits. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to contact the undersigned at the telephone number listed below.

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Respectfully submitted,

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